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OFFICE OF PETITIONS

In re Application of	:	
Joffre B. Baker, Maureen T. Cronin, Steve	:	
Shak, and Jose Baselga	:	
Application No. 10/714,195	:	DECISION ON PETITION UNDER
Filed: November 14, 2003	:	37 C.F.R. §1.47(a)
Attorney Docket No.: 39740-0005A	:	
Title: GENE EXPRESSION PROFILING OF	:	
EGFR POSITIVE CANCER	:	

This is a decision on the petition under 37 CFR § 1.47(a)¹, filed September 21, 2004, to revive the above-identified application, and to accept the declaration without the signature of joint inventor Baselga.

The above-identified application was filed on November 14, 2003, identifying Joffre B. Baker, Maureen T. Cronin, Steve Shak, and Jose Baselga as joint inventors. On February 24, 2004, applicant was mailed a "Notice to File Missing Parts of Nonprovisional Application - Filing Date Granted" (Notice), requiring an executed oath or declaration² in compliance with 37 C.F.R. §1.63 and a surcharge for its late filing. This Notice set a two-month period for reply.

² A grantable petition under 37 C.F.R. §1.47(a) requires:

- (1) the petition fee of \$130;
- (2) a surcharge of either \$65 or \$130 if the petition is not filed at the time of filing the application, as set forth in 37 CFR § 1:16(e);
- (3) a statement of the last known address of the non-signing inventors;
- (4) either
 - a) proof that a copy of the entire application (specification, claims, drawings, and the oath or declaration) was sent or given to the non-signing inventor for review and proof that the non-signing inventor refuses to join in the application or
 - b) proof that the non-signing inventor cannot be found or reached after diligent effort;
- (5) a declaration which complies with 37 CFR §1.63.

² The declaration was not executed.

With the instant petition, Petitioner has filed a declaration which has been executed by each of the joint inventors save Mr. Baselga. Petitioner has further included two statements of facts, a copy of a letter, a copy of an e-mail, a confirmation receipt from federal express, the petition fee, the surcharge, and a five-month extension of time to make timely this response.

Petitioner has met requirements (1) – (2) above.

Regarding the third requirement, petitioner has failed to include a statement of the last known address of the non-signing inventor³.

Regarding the fourth requirement above, it is not clear if the non-signing inventor actually received the above-mentioned papers. The declaration of facts asserts that a copy of the application was sent to the work address of the non-signing inventor, which is given as “Vall d’Hebron University Hospital, Pg. Vall d’Hebron, 119-129, Barcelona, 08035, Spain.” The correspondence described above is not sufficient to make the necessary showing that the non-signing inventor was ever presented with a copy of the application and a declaration, for the Office requires these materials to be sent to the residence of the inventor, as that is most likely the location where he might receive mail. Unfortunately, it is not clear where precisely this address is, since no last known address was revealed. It is noted that the declaration lists a post office address of Ganduxer 119, Barcelona, 08022, Spain.

Furthermore, the Federal Express tracking report establishes that the package was received by one S. Ello. It is not clear who this individual is, and it has not been established that this individual delivered the package to the non-signing inventor. What is clear is that the non-signing inventor did not receive the package directly from Federal Express.

As it is not clear if the non-signing inventor ever received the materials, it follows that one cannot refuse to sign something which one has not seen

If the non-signing inventor normally received correspondence at work, then a statement to this effect should be supplied by one having firsthand knowledge of this. If the declaration is to be believed, the papers will need to be delivered to the residential address, as this is the location where the non-signing inventor customarily receives mail.

Regarding item (5) above, Depending on the resolution of item (4) above, a new declaration may need to be submitted – if the non-signing inventor normally receives his mail at work, his work address should be listed on the declaration along with his residential address, and the new declaration will be required to reflect this.

Consequently, the petition under 37 C.F.R. §1.47(a) is **DISMISSED**.

Any request for reconsideration or petition under 37 CFR 1.137(a) must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extension of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled

³ See MPEP 409.03(e).

"Renewed Petition Under 37 CFR 1.47(a)". This is not a final agency action within the meaning of 5 U.S.C 704.

The renewed petition should indicate in a prominent manner that the attorney handling this matter is Paul Shanoski.

To help assure prompt and proper attention to your response, please see Request for Alert Concerning Submitted Petitions, 1282 Official Gazette (May 18, 2004) for further information on how to assist the Office in delivering your submission to the correct location. The Petitioner may wish to consider telephoning the undersigned one month after the submission is made to confirm that the documents were properly delivered.

Any renewed petition may be submitted by mail⁴, hand-delivery⁵, or facsimile⁶.

The application file will be retained in the Office of Petitions for two (2) months.

The general phone number for the Office of Petitions which should be used for status requests is (571) 272-3282. Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225.



Paul Shanoski
Senior Attorney
Office of Petitions
United States Patent and Trademark Office

⁴ Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

⁵ Customer Window, Mail Stop Petition, Crystal Plaza Two, Lobby, Room 1B03, Arlington, Virginia 22202.

⁶ (703) 872-9306 - please note this is a central facsimile number, and as such, there will be a delay in the delivery of the facsimile to the undersigned, which could be as much as one month.